

REMARKS

In the Office Action, the Examiner rejects claims 24, 28, and 32 under 35 U.S.C. § 112, second paragraph, as being indefinite; rejects claims 24, 28, and 32 under 35 U.S.C. § 101 as directed to non-statutory subject matter; and allows claims 1-6, 14-23, 25-27, and 29-31. Applicants appreciate the Examiner's indication that claims 1-6, 14-23, 25-27, and 29-31 are allowed, but respectfully traverse the above rejections.¹

By way of the present amendment, Applicants amend claims 3-6, 15, 16, 24, 28, and 30-32 to improve form. No new matter has been added by way of the present amendment. Claims 1-6 and 14-32 are pending.

Claims 24, 28, and 32 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for reciting functional limitations of an apparatus. Applicants respectfully traverse this rejection.

It is well established that Applicants can define an apparatus claim structurally or functionally. See In re Swinchart, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) ("[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims."). Thus, contrary to the Examiner's allegation, there is no requirement that an apparatus claim be structurally distinguishable over the prior art. Moreover, the Examiner's reliance on In re Schreiber, 128 F.3d 1473, 1477-78,

¹ As Applicants' remarks with respect to the Examiner's rejections overcome the rejections, Applicants' silence as to certain assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, reasons for modifying a reference and/or combining references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or that such requirements have been met, and Applicants reserve the right to dispute these assertions/requirements in the future.

44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) for ignoring the functional features recited in Applicants' claims 24, 28, and 32 is misplaced. As correctly noted by the Examiner, in In re Schreiber, the Board found a claimed apparatus to be anticipated by the prior art "because the limitations at issue were found to be inherent in the prior art reference" (emphasis added). Id. The Examiner provides no evidence that the functional features recited in Applicants' claims 24, 28, and 32 are inherent in the art of record. Thus, the Examiner has not properly established that the claims are indefinite.

Claims 24, 28, and 32 stand rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Specifically, the Examiner states that the functions of the nodes defined by these claims may be embodied entirely in software (Office Action, pg. 3). Without acquiescing in the Examiner's rejection, but merely to expedite prosecution, Applicants amend claims 24, 28, and 32 to recite "a memory to store instructions" and "processing logic to execute the instructions." As such, withdrawal of the rejection to claims 24, 28, and 32 under 35 U.S.C. § 101 are respectfully requested.

If the Examiner believes that the application is not now in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned to discuss any outstanding issues.

Application No. 10/803,509
Amendment dated September 17, 2008
Reply to Office Action of June 17, 2008

Docket No.: BBNT-P01-258

Applicants believe no fee is due with this response other than as indicated in the enclosed Amendment Transmittal. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. BBNT-P01-258 from which the undersigned is authorized to draw.

Dated: September 17, 2008

Respectfully submitted,

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